



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/590,889      | 06/04/2007  | Peter Svete          | 33668US-PCT         | 3731             |

72554 7590 02/19/2009  
SANDOZ INC  
506 CARNEGIE CENTER  
PRINCETON, NJ 08540

|          |
|----------|
| EXAMINER |
|----------|

RAO, SAVITHA M

|          |              |
|----------|--------------|
| ART UNIT | PAPER NUMBER |
|----------|--------------|

1614

|           |               |
|-----------|---------------|
| MAIL DATE | DELIVERY MODE |
|-----------|---------------|

02/19/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

|  |                                      |                                     |  |
|--|--------------------------------------|-------------------------------------|--|
| <p align="center"><b>Advisory Action</b><br/><b>Before the Filing of an Appeal Brief</b></p> | <b>Application No.</b><br>10/590,889 | <b>Applicant(s)</b><br>SVETE ET AL. |  |
|  | <b>Examiner</b><br>SAVITHA RAO       | <b>Art Unit</b><br>1614             |  |

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 30 January 2009 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☐ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### NOTICE OF APPEAL

2. ☒ The Notice of Appeal was filed on 01/30/2009. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

#### AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
- (a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ They raise the issue of new matter (see NOTE below);
- (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
- The status of the claim(s) is (or will be) as follows:
- Claim(s) allowed: \_\_\_\_\_.
- Claim(s) objected to: \_\_\_\_\_.
- Claim(s) rejected: 1-10 and 18-19.
- Claim(s) withdrawn from consideration: \_\_\_\_\_.

#### AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

#### REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:  
See Continuation Sheet.
12. ☐ Note the attached Information *Disclosure Statement*(s). (PTO/SB/08) Paper No(s). \_\_\_\_\_
13. ☐ Other: \_\_\_\_\_.

/Ardin Marschel/  
Supervisory Patent Examiner, Art Unit 1614

/SAVITHA RAO/  
Examiner, Art Unit 1614

Continuation of 3. NOTE: The amended claims , 7,8 and 18 submitted on 01/30/2009 add new limitations that ultimately change claim scope and would require new searching and new rejections. Specifically, the amendment to remove the "about" modifier in these claims narrows the scope of the claims 1,7,8 and 10 in terms of the concentration of the stabilizing substance much further than the claims submitted on 07/10/2008..

Continuation of 11. does NOT place the application in condition for allowance because: The amended claims 1,7,8 and 18 submitted on 01/30/2009 add new limitations that ultimately change claim scope and would require new searching and new rejections. Specifically, the newly added limitations, removal of the "about" modifier with references to the lower limit of the stabilizer in instant claims 1, 7, 8 and 18 narrows down the claim from those previously presented on 07/30/2008.

Applicants arguments in response to the final rejection mailed on 09/20/2008 has been considered but are deemed partly unpersuasive. Applicant's argument against the 102 rejection that they they do not believe the calculated amount of 0.95% stabilizer from Antoncic is within the range of from "about" 1% to about 10% stabilizer as called for in their claims contradicts their statement that "values below but nonetheless very near 1 weight percent stabilizer and, depending on the situation, compositions having more than 0.95% total stabilizer may still be found to be near enough to 1% to fall under the scope of Applicants' current claims". If values found to be slightly more than 0.95 % are within the scope, applicant's present no data to indicate what that slightly higher concentration is, and as per applicant's definition it can even be 0.955% . As such absence of any definition of "about" and "slightly higher" 0.95% recited by Antoncic would be anticipated. Accordingly, applicant's argument against the 102 rejection is not found to be persuasive.

Applicant's statement "Antoncic reference were, at the time the invention was made, owned by the same entity or subject to an obligation of assignment to the same entit" overcomes the 103 rejection.

/Ardin Marschel/  
Supervisory Patent Examiner, Art Unit 1614